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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/502,182	Applicant(s) TAFLA, SIVAN	
	Examin r Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45,47 and 49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45,47 and 49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to the paper(s) filed 11/14/2002.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5-11, 45 and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims merely set forth structure to, or methods for downloading either a webpage, advertising layer or both. No structure or steps are set forth for actually displaying/triggering the animation which overlays the webpage. Simply downloading or uploading files/object(s) does not result in a useful and tangible result; therefore these claims do not represent statutory subject matter. The functional language of a layer containing animated content "adapted to run across a webpage" does not clearly and positively set forth the act of the animation. Similarly, downloading a layer "for displaying the animated content" does not actually include the positive displaying/animating the content. To avoid this rejections, applicant should clearly set forth structure or steps displaying/triggering the display of the animated content on top of a displayed webpage.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5, 15, 27 and 39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- There is no enabling disclosure for providing an animated video clip which travels across the screen. While vector animation such as Flash provides the artisan with methods to provide animation, an enabling disclosure concerning animating a video object is not provided. Applicant's disclosure on page 8 lines 10-13 indeed suggests animating a video clip, no teachings or examples are provided on how to accomplish such a task.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3, 10, 12-32 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 3 appears to conflict with base claim 1; it is unclear which server provides the uploading/downloading..."a web server" or "a different web server". Claim 3 cannot depend from claim 1 and change the features of claim 1, it can only limit the scope.

- Claim 10, step (b) is disclosed as performed during an idle period.
- Claim 12 line 4, there is no antecedent basis for "the host web page".
- Claim 19 does not appear to limit the base claim; it appears that the features of 19 are already present in claim 12.
- Claim 21 line 3 and claim 45 line 4, there is no antecedent basis for "the web server".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-45, 47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Zapa Digital (WO 97/35280) in view of Sony (WO 98/47090).

Regarding claims 1, 12, 45-50, Zapa Digital teaches systems and methods for downloading an animated layer from a server, the animated layer being superimposed over a web page shown in a web browser (e.g. yahoo! Webpage) [fig 2, 6A, 6B, pg 25 lines 23-25]. Zapa Digital describes the animation as advertising content [pg 32 lines 30-31]. The animated object(s) move across the screen portions [pg 25 line 35 to pg 26 line 5, pg 17 lines 19-25] and the web page underneath is fully active and responsive, save for the portion covered by the boundary of the animated object. The animation (Smart Object) is a web page/browser file (such as HTML or VRML) that is separate

from the underlying displayed web page, but layered on top of it [pg 4 lines 14-17, pg 6 lines 12-17, pg 7 lines 1-6, pg 10 line 1-5]. The animation can be triggered internally by the Smart Object animation file, or by an external trigger such as a Scene Manager, or a JAVA applet provided by a server [pg 6 lines 26-28, pg 18 lines 7-13]. Zapa's advertisements are not described as interstitial. Sony teaches methods for interstitially providing advertisements to a user browser during idle periods. After a user downloads a web page, the client is idle while the user reads the page. During this time an advertisement is downloaded to the client for display when the user navigates to a new page and while the new page is being downloaded. It would have been obvious to one of ordinary skill at the time of the invention to have transferred Smart Object animation files to the client computers of Zapa during idle web browsing periods and triggered them during interstitial periods, as taught by Sony so that ads can be politely displayed to give the user something to read while the successive page is retrieved and loaded.

Regarding claims 4, 7-9, 17, 18, 21-26, 29-31, 33-38, 41-43, Zapa Digital teaches that the triggering of various animations can be accomplished by programming integral with the animation object itself, or by external, programmed scripts [pg 18 lines 7-13]. The animations can be triggered without interaction by the user, such as proximity of one character in relationship to another or collisions, or by user-action such as mouse selection [pg 6 lines 24-36, pg 23 lines 22-26]. Zapa Digital also teaches animations to be triggered by the server through the use of a downloaded mobile program (JAVA server applet) [pg 34 lines 29-31]. Regarding claim 14, the server's processor which sends the JAVA-based triggers is inherently responsive to a clock.

Regarding claims 5, 15, 27 and 39, the animation portions are taken to be "video clips", as they are visual portions of displayed motions.

Regarding claim 6, 16, 28 and 40, the smart objects that comprise the animated objects are taken to be animated by way of vector scripts. The objects include mathematical descriptions of the image element as well as data describing the position, orientation and motion of such object from one animation frame to the next [pg 4 lines 18-20, pg 5 lines 3-8, pg 6 lines 29-31].

Regarding claims 11, 20, 32 and 44, Zapa Digital describes portions of the animated objects as partly transparent (translucent) so that the underneath content is visible [pg 25 lines 21-25].

Regarding claims 2 and 3, Sony teaches that the advertising content can come from the server as the requested content, or from a different server [pg 5 lines 8-11].

Regarding claims 5, 15, 27 and 39, it would have been obvious to one of ordinary skill at the time of the invention to have provided any type of known digital animation formats with the moving objects of Zapa Digital, including video clips and animated gifs, for example, so as to provide a wide variety of enticing advertising. Further, applicant provides no criticality to the types of format, be it vector-based or video clips. Applicant's claiming of either type of format suggests a lack of criticality to this feature.

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9. **Claims 1-45, 47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Sony in view of Zapa.** Sony teaches interstitial advertising content that is displayed to used during web surfing. Zapa teaches animation methods to provide an

animated advertising layer on top of user-requested web pages. It would have been obvious to one of ordinary skill at the time of the invention to have provided interstitial advertising to web surfers, as taught by Sony, but in an animated, layered format as taught by Zapa, so that the interstitial advertising content is enticing and dynamic.

Response to Arguments

10. Applicant's arguments filed 11/14/2002 have been fully considered but they are not persuasive. Applicant argues that the 101 rejection is improper because the animation is inherently built into the files and that the server does not need to carry out the animation. While the server only transmits the files to the client, mere transmission of a file does not provide a useful result, even if the file has the property to provide animation subsequent to the transmission. Applicant must include the display of the advertising animation in the claims in order to produce a useful result.

Applicant argues that the invention enables an independent entity source to provide the ad content, separate from the providing source of the web page. However the claims only call for a web page layer that is "separate from the web page". There is no claiming of a separate source; an animation web page layer is inherently taken to be separate from the web page underneath, even though both are presented together.

Applicant argues that there is no motivation to trigger the ad. Zapa clearly teaches triggering of the animation, either by a trigger internal to the Smart Object file(s), or by an external trigger such as through JAVA.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc
January 26, 2003